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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/530,815	07/12/2000	HELMUT LOTH	H3146	3579

423 7590 01/08/2003

HENKEL CORPORATION  
2500 RENAISSANCE BLVD  
STE 200  
GULPH MILLS, PA 19406

EXAMINER

REDDICK, MARIE L

ART UNIT	PAPER NUMBER
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1713

10

DATE MAILED: 01/08/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application N .

09/530,815

Applicant(s)

LOTH ET AL.

Examiner

Judy M. Reddick

Art Unit

1713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 07 October 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 6-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 6-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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**DETAILED ACTION**

**Response to Amendment**

1. Pursuant to a extensive review of the file and an updated search, new prior art has come to the Examiner's attention and a rejection based on such is deemed proper and is as set forth *infra*. The indication of allowability per the previous Office Action(paper no. 8, 07/09/02) is herein regrettably rescinded.

**Claim Rejections - 35 USC § 112**

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

*The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.*

3. Claims 6-26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A) The recited "residues", in this context, constitutes indefinite subject matter as per it not being readily ascertainable as to how such further limits the antecedently recited "copolymer". "units" in lieu of "residues" is suggested.

B) The recited "molecular weight between 300 and 1500" per claim 17 constitutes indefinite subject matter as per it not being readily ascertainable as to the type of molecular weight intended, i.e. "wt. avg." or "no. avg.", the two being substantially different(Ex parte Simpson, 61 USPQ2d 1009).

C) The recited "comprising one or more fatty acid esters" per claim 21 constitutes indefinite subject matter as per it not being readily ascertainable as to how such further limits the antecedently recited "fatty compounds". Use of "wherein the fatty compounds comprise one or more fatty acid esters" is suggested.

**Claim Rejections - 35 USC § 102**

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4. *The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:*

*A person shall be entitled to a patent unless –*

*(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.*

5. *The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:*

*(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.*

6. *Claims 6-26 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over D'Alelio(U. S. 2,442,588), Antlfinger et al(U.S. 3,486,930), Reinhard et al(U.S. 3,551,374), Fukuda et al(U.S. 3,706,589), Patella(U.S. 3,736,287), Reed(U.S. 3,738,991) or Patella(U.S. 3,749,690).*

A) *D'Alelio teaches compositions, useful as sealing materials, formed from combining a) a terpolymer latex derived from i) acrylonitrile, ii) at least one acrylic acid ester and iii) at least 1 1,3-diene and other conventional additives such as plasticizers, extenders, lubricants, fillers, etc. and include compounds such as fatty compounds falling within the scope of the claims. See, col. 1-6, 8-10, 12-15(examples inclusive) of D'Alelio.*

B) *Antlfinger et al teach compositions, useful as binders, and defined basically as containing i) vinyl halide copolymer latexes derived from at least one vinyl halide and at least one other vinyl comonomer which includes (meth)acrylonitrile, (meth)acrylic acid and esters of (meth)acrylic acid, ii) a drying oil or drying alkyd resins and include compounds which overlap in scope with the claimed fatty compounds and iii) other conventional adjutants such as fillers, antioxidants, stabilizers, plasticiz rs, etc. See cols. 1-5 and the claims of Antlfinger et al.*

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**C) Reinhard et al teach and exemplify caulking and sealing compounds defined as containing i) an emulsion polymer (A) derived from an ester of an ethylenically unsaturated carboxylic acid containing 3-5 carbon atoms and includes copolymers of n-butyl acrylate and acrylonitrile, ii) a polymer (B) derived from isobutylene or isoprene and iii) conventional adjuncts such as plasticizers, drying oils, surfactants, fillers, etc. and including fatty compounds falling within the scope of the claimed fatty compounds. See, the Abstract, cols. 1-6, Runs 1-4, 7-10 & 12 and the claims of Reinhard et al.**

**D) Fukuda et al teach compositions defined basically as containing synthetic resin emulsions of acrylonitrile-acrylate copolymers, wax compounds such as natural compounds and including compounds such as sperm oil and overlapping in scope with the claimed fatty compounds, water and other conventional adjuncts such as fillers, plasticizers, etc. See cols. 1, 3-5 and the claims of Fukuda et al.**

**E) Patella'690 and Patella'287 teach compositions, useful in caulking, defined basically as containing a aqueous polymer emulsion wherein the polymer is a pentapolymer derived from a) a short-chain alpha, beta- ethylenically unsaturated mono- or polycarboxylic acid, b) acrylonitrile, c) an amide, d) an alkyl acrylate and e) vinyl acetate or an alkyl methacrylate and other conventional adjuncts such as pigments, extenders, fillers, lubricants, etc. and includes a water-dispersible lecithin compound and overlaps in scope with the claimed fatty compound. See cols. 1, 3, 8 and the Runs of Patella'287 and Patella'690.**

**F) Reed teaches compositions, useful as caulks and sealants, defined basically as containing i) an acrylic polymer latex wherein the acrylic polymer includes an alkyl acrylate/acrylonitrile copolymer and other conventional adjuncts such as extenders, pigments, plasticizers, etc. which includes compounds overlapping in scope with the claimed fatty compounds. More specifically, Reed exemplifies compositions defined basically as containing an acrylate copolymer latex, an aqueous solution of triethanolamine, a wax component and a fatty acid such as stearic acid or any other fatty acid and overlaps in scope with the claimed fatty compound. See cols. 1, 3-6 and 10-12, Run VI and the claims inclusive, of Reed.**

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*Each of D'Alelio, Antfinger et al, Reinhard et al, Fukuda et al, Patella'287, Patella'690 and Reed therefore anticipate the instantly claimed invention, in both content and character with the understanding that the components of patentees overlap in scope, in both content and character, with the components of the claimed invention.*

*As to the dependent claims, the limitations are either taught by patentees, suggested by patentees or would have been obvious to the skilled artisan and with a reasonable expectation of success.*

*While patentees supra may not label the fatty compounds as a plasticizer, the discovery of a new property or use for a previously known compound cannot impart patentability to claims to that compound, even if the property or use is unobvious from the prior art (In re Schoenwald, 22 USPQ 1671).*

#### **Response to Arguments**

7. *Applicant's arguments filed 10/07/02 have been fully considered but they are not persuasive.*

*Relative to the 112, 2<sup>nd</sup> paragraph issues—While Counsel, in a good faith effort, attempted to remedy the 112 issues raised in the previous Office Action, some issues remain and new 112 issues were created and are as set forth supra.*

#### **Conclusion**

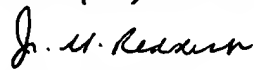
8. *The additional prior art made of record and listed on the attached FORM PTO 892 is cited as of being illustrative of the general state of the art.*

*Any inquiry concerning this communication or earlier communications from the examiner should be directed to Judy M. Reddick whose telephone number is (703)308-4346. The examiner can normally be reached on Monday-Friday, 6:30 a.m.-3:00 p.m..*

*If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (703)308-2450. The fax phone numbers for the organization where this application or proceeding is assigned are (703)872-9310 for regular communications and (703)892-9311 for After Final communications.*

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***Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)305-8183.***

  
**Judy M. Reddick**  
**Primary Examiner**  
**Art Unit 1713**

**JMR**   
**December 23, 2002**